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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,573	03/15/2004	Daniel Perlman	DVRS-003XX	1722
207 7590 10/26/2007 WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109			EXAMINER RAMDHANIE, BOBBY	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 10/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/800,573	Applicant(s) PERLMAN, DANIEL	
	Examiner Bobby Ramdhanie, Ph.D.	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/15/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/08/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, are drawn to a method of covering an opening in a laboratory container, classified in class 53, subclass 478.
 - II. Claims 14-18, are drawn to a sterile assembly, classified in class 221, subclass 63.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the method of covering an opening in a laboratory container can be accomplished with either plastic wrap or a sheet of parchment paper with a rubber band.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the

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requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Andy Farmer on 09/24/07 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 7, & 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore (US2875563). Regarding Claim 1, Moore teaches a method of covering an opening in a laboratory container with aluminum foil to provide a heat resistant and solvent-resistant closure, comprising the steps of: Providing a preformed aluminum foil cup (Figure 1) of sufficient size to cover said opening, wherein said cup is free of any substance that could contaminate said container (Column 4 lines 28-30), and wherein

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said cup comprises a bottom wall and a raised perimeter sidewall continuous with, and surrounding said bottom wall inverting and placing said cup over said opening (Column 1 lines 15-22), optionally adjusting the shape and diameter of said cup so as to fit over said opening, and compressing the sidewall of said cup to a friction fit (Column 1 lines 35-38; Examiner takes the position that crimpling causes a friction fit.) around said opening.

6. For Claim 2, Moore teaches the method of Claim 1 wherein said cup is sterile (Column 4 lines 28-30).

7. For Claim 7, Moore teaches the method of Claim 1, wherein said cup is an open dish-shaped structure selected from the group consisting of tubs, trays, cups, bowls, canisters, and other vessels that are free of any structural feature that would interfere with the use of said cup as a covering for a laboratory opening (Column 1 lines 15-22).

8. For Claim 8, Moore teaches the method of Claim 1, wherein the surface shape of said sidewall is selected from the group including pleated, fluted, crinkled, and dimpled (Column 1 lines 22-28).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Perlman (US5302344). Regarding Claim 3, Moore teaches the method of Claim 2 wherein said cup has been sterilized (Column 4 lines 28-30). Moore does not teach that the sterilization process is selected from the group consisting of radiation sterilization and gas sterilization. Perlman teaches this feature (Column 2 lines 61-62). It would have been obvious to one of ordinary skill in the art to modify Moore with Perlman because according to Perlman aluminum foil may fail to possess requisite chemical stability in the presence of salts and other chemicals (Column 2 lines 32-56).

12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Federal Specifications for Aluminum Foil of 1974. Regarding Claim 4, Moore teaches the method of Claim 1. Moore does not teach the method of Claim 4 wherein the aluminum foil used to fabricate said cup is between approximately 0.0003 inches and approximately 0.002 inches thick. The Federal Specifications for Aluminum Foil of 1967 teaches this feature. The Federal Specifications for Aluminum Foil of 1967 teaches that Grade A foil, Type I has a thickness from 0.0007 inches to 0.002 inches

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(Page 4; 3.6.1.1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Moore with the Federal Specifications for Aluminum Foil of 1974 because according the Specifications Grade A foil contains less than 0.01 percent lead, arsenic, or cadmium (Pages 3; 3.1.1).

13. For Claim 5, Moore in combination with the Federal Specifications for Aluminum Foil of 1974 teaches the method of Claim 4 wherein said aluminum foil is between approximately 0.0005 and approximately 0.001 inches thick (Page 4; 3.6.1.1).

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Lemelson (US3385025). Regarding Claim 6, Moore teaches the method of Claim 1, wherein the shaping of said cup is produced using a mechanical forming die (Column 1 line 20). Moore does not teach that a forming means selected from the group consisting of pressure, heat, and a combination thereof is used in the shaping of said cup. Lemelson teaches these features (Column 3 lines 10-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Moore with Lemelson because according to Lemelson this would allow different shapes of the aluminum containers to be formed at one time (Column 3 lines 45-51).

15. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of PGC Scientifics Corporation (1994/1995 Catalog). Regarding Claim 9, Moore teaches all of the claim limitations according to Claim 1. Moore does not teach the method of claim 1 wherein the length measured across the largest dimension of said bottom wall is between 1 inch and 6 inches. PGC Scientifics Corporation teaches a laboratory container (Clear Fused Quartz Beaker; Low Form Griffin type) with a

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diameter opening between 1 to 6 inches (Page 52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Moore with PGC Scientifics Corporation because according to Moore, the side wall of each of these particular containers are shaped by forming crinkles and pleated ridges in the aluminum foil in order to form the one piece body and the extent of this wall pleating of foil reaches its maximum on the upper portion of the wall periphery that forms the open mouth of the container (Column 1 lines 22-28).

16. Claims 10 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore. Regarding Claim 10, Moore teaches the method of Claim 1. Moore does not teach that the height of said perimeter wall is between 0.25 inches and 2.5 inches. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Moore because the height of the perimeter wall is dependent on the die that is used for the depression. One skilled in the art would be able to manufacture dies with the desired height requirements for a particular run of the product, including a height of the perimeter wall, within the range of 0.25 to 2.5 inches.

17. For Claim 11, Moore teaches the method of Claim 1. Moore does not teach the method of Claim 10 wherein said height is between 0.5 inch and 1.5 inches. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Moore because the height of the perimeter wall is dependent on the mechanical die head that is used for the depression. One skilled in the art would be able to manufacture mechanical dies with the desired height requirements for a particular run

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of the product, including a height of the perimeter wall within the range of 0.5 to 1.5 inches.

18. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Conti (US2411083) and Wright (US2256603). Regarding Claim 12, Moore teaches all of the claim limitations according to Claim 1. Moore does not teach the method of Claim 1 where said cup is manufactured without using a lubricant that could contact and contaminate said cup or multiple cups in a nested stack of similar cups. Conti teaches this feature (Column 7 lines 29-33). It would have been obvious for one of ordinary skill in the art to modify Moore with Conti because according to Wright, roll oils, drawing compounds, and die swabbing oils which have been in use up to this time have the disadvantage of leaving on the annealed articles, dark stains (Page 1 Left Column lines 26-29).

19. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of The University at Stony Brook, Department of Chemistry, General Chemistry Laboratory – Desk Inventory Form. Regarding Claim 1, Moore teaches all of the claim limitations according to Claim 1. Moore does not teach the method of claim 1 wherein said container is selected from the group consisting of a beaker, a flask, a bottle, a graduated cylinder, a test tube, a centrifuge tube, a cuvette, a vial, and a scoop. The University at Stony Brook, Department of Chemistry, General Chemistry Laboratory – Desk Inventory Form teaches these features (Page 1 and 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Moore with The University at Stony Brook, Department of Chemistry, General Chemistry

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Laboratory – Desk Inventory Form because these items would normally be found in a laboratory setting.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bobby Ramdhanie, Ph.D. whose telephone number is 571-270-3240. The examiner can normally be reached on Mon-Fri 8-5 (Alt Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BR


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